

**REMARKS**

Claims 19-34 are pending. Claim 19 is amended. Reconsideration of the rejections set forth in the Office Action is respectfully requested.

***Amendments***

Claim 19 is amended to clarify that a return time is assigned to a patron so that the patron can return to the attraction. Therefore, the method claimed herein differs from conventional reservation systems which provide specifically set-aside time slots. Rather, a method that provides return times, and not allocation of reserved time slots, is provided.

***Claim Rejections - 35 U.S.C. § 103(a)***

The Office Action states that Claims 19-26, and 30-34 under 35 U.S.C. 103(a) are unpatentable over Mahoney (U.S.P.N. 5,502,806) in view of Decker (U.S.P.N. 6,167,443) in further view of Official Notice of COMCAST, in further view of Baranowski (U.S.P.N. 6,813,608), in view of Official Notice that television is a means for communicating an order, and in view of Gatto et al. (U.S.P.N. 5,905,521). The Office Action also states that Claims 27, 28, and 29 under 35 U.S.C. 103(a) are unpatentable over Mahoney in view of Decker in further view of Official Notice of COMCAST, in further view of Baranowski, in view of Official Notice that television is a means for communicating an order, in view of Gatto et al., and in further view of Christie (U.S.P.N. 5,502,806). Applicants respectfully disagree with the rejections set forth in the Office Action and submit that Claims 19-34 are patentable over the cited references for at least the following reasons.

**I. Mahoney in view of Decker et al. and Baranowski do not show or suggest the claimed inventions**

Mahoney describes a reservation system, not a return time allocation system as called for in claim 19. See, for example, column 5, lines 25-30 among other locations in the Mahoney specification. Here, Mahoney teaches that places that have been selected and confirmed by a

card holder are no longer available to the non-card patrons. In other words, the spaces that are selected by a card holder are reserved or taken out of the inventory that can be used by the non-card holders. In contrast, claim 19 calls for a system that allocates a return time, but no spaces are reserved or removed from the inventory available for loading the attraction on a first-in first-out basis.

Neither Decker nor Baranowski supply these deficiencies of the Mahoney reference. Accordingly, claim 19 and claims 20-34 that depend from claim 19 are allowable under 35 U.S.C. 103.

## **II. Baranowski is not prior art**

Upon study of the Baranowski reference, it is noted that the Baranowski reference claims priority to earlier filed U.S. Provisional Application No. 60/158,725, filed on March 14, 2000. In citing Baranowski, the Examiner cites language at Column 13, Lines 49-51. This text was only added with the filing of the Utility Patent Application (filed on Mar. 14, 2000) and therefore the effective date of the Baranowski reference is March 14, 2000, the filing date of the Utility Patent Application. The present application claims the benefit of U.S. Patent Application No. 09/617,721, filed July 17, 2000 and of US Application No. 09/372,405, filed August 10, 1999, now U.S. Patent 6,173,209. Therefore, Baranowski is not valid prior art and it is respectfully requested that the rejections under 35 U.S.C. §103 be withdrawn on this basis.

## **III. The proposed combination is impermissible**

### **a. Hindsight**

The Examiner is respectfully reminded of basic principles when combining various references in order to reject a claim: "The 'as a whole rule' prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art component.

Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result – often the essence of invention.” Judge Rader – *Princeton Biochemicals Inc. v. Beckman Coulter Inc.*, (Fed. Cir. 1995)(emphasis added).

The Examiner has done exactly that: break the invention into components and use the invention as a roadmap to find each prior art component. There are six different components assembled together to make the combination suggested in the Office Action: 1) Mahoney, 2) Decker, 3) Official Notice of COMCAST, 4) Baranowski, 5) Official Notice that television is a means for communicating an order, 6) Gatto et al. With respect to Claims 27-29, yet a seventh reference is used--Christie. This is a clear use of impermissible hindsight to reconstruct Applicants claim by assembling together bits and pieces of multiple references. Applicants submit the combination proposed in the Office Action is the product of hindsight, and therefore submit that the rejection of obviousness is improper.

b. Motivation to Combine

Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” As such, the question is whether one of ordinary skill in the art would have been, at the time the invention was conceived, motivated by an implicit or explicit teaching or suggestion found in the prior art to combine the references as combined in the Office Action. Furthermore, the second requirement set by the Federal Circuit mandates that a reasonable expectation of success must also be taught in the prior art.

In addition, the Office Action offers the following motivation to modify the combination (Mahoney and Decker) with Baranowski: “[i]t would be an obvious modification to Mahoney et al. to place an ordering system in a hotel e.g. resort, as taught by Decker et al. and to use the television as a means for communicating an order to make the object of the order a reservation request for an amusement attraction as taught by Baranowski, the motivation being the use of the television in Decker which already presents the ordering menu on the television to reserve a place in line at an amusement park which is an obvious annexation of a hotel.” None of this language, or a similar suggestion is found in any of the cited prior art. Applicants respectfully request the Examiner to cite specific sections of the cited prior art where the suggestion to make the proposed combination is taught or discussed.

Absent such citation of suggestion or motivation to combine, Applicants submit that one of ordinary skill in the art would not have combined, at the time the invention was made, Mahoney and Decker and Baranowski in the manner proposed by the Examiner.

At least for the foregoing reasons, Applicants submit that independent Claim 19 is not rendered obvious by Mahoney in view of Decker and in further view of Baranowski, the Official Actions, and Gatto et al. Claims 20-34 depend from Claim 19. Therefore, Applicants submit that dependent Claims 20-34 are not rendered obvious by Mahoney, Decker, Baranowski, the Official Actions, and Gatto et al. either. Therefore, Applicants respectfully request that the rejections to Claims 19-34 be withdrawn.

*Conclusion*

Applicants submit that the present application is in condition for allowance. Should matters remain, which the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone the Applicants' undersigned agent. The Director is authorized to charge any additional fee(s) or any underpayment of fee(s), or to credit any overpayments to Deposit Account Number **50-2638**. Please ensure that Attorney Docket Number 58085-010203 is referred to when charging any payments or credits for this case.

Respectfully submitted,



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